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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/514,651	02/29/2000	MASANORI KAMATA	P18896	2074
7055	7590	04/26/2005	EXAMINER	
GREENBLUM & BERNSTEIN, P.L.C.			POON, KING Y	
1950 ROLAND CLARKE PLACE			ART UNIT	
RESTON, VA 20191			PAPER NUMBER	

2624

DATE MAILED: 04/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/514,651

Applicant(s)

KAMATA, MASANORI

Examiner

King Y. Poon

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2005 and 14 January 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 35-46 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 35-46 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 February 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1/14/2005 has been entered.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 41 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Regarding claim 41: The limitations of "wherein the predetermined character comprises a pause" is contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that

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the inventor(s), at the time the application was filed, had possession of the claimed invention.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 41 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 41 is claiming the numerical value input by the panel includes a pause. It is unclear what number (from 0-infinity) is the pause number.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 35-46 are rejected under 35 U.S.C. 102(b) as being anticipated by Matsunai (US 5,357,350).

Regarding claims 35, 44: Matsunai teaches an image recording apparatus (fig. 1) having a copy mode (STP1, fig. 4) and a facsimile mode (STP7, fig. 4), the image recording apparatus comprising; a panel section (column 5, line 18) which has input

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keys (column 5, line 11) operable to input a numerical value corresponding to at least one of a number of copies (column 6, lines 66-67, column 7, lines 1-2) in the copy mode and a telephone number of a destination in the facsimile mode (column 7, lines 3-10); a display section (18e, fig. 2A, 2B, column 5, lines 19-21) which displays at least one of a screen for the copy mode and a screen for the facsimile mode, a display capacity of the screen in the copy mode being smaller than a display capacity of the screen in the facsimile mode (STP6, fig. 4); and a controller (PPC 2, column 6, lines 45-46) which, when the copy mode is set and when the numerical value input by the panel section exceeds the display capacity of the screen in the copy mode (STP7 fig. 4), switches from the copy mode to the facsimile mode.

Regarding claim 36: Matsunai teaches wherein the display capacity of the screen, when the input numerical value corresponding to the number of copies is displayed, is smaller than the display capacity of screen, when the input numerical value the screen, when the input numerical value corresponding to the telephone number of the destination is displayed (STP6, fig. 4).

Regarding claim 37: Matsunai teaches an image recording apparatus (fig. 1) having a copy mode and a facsimile mode (fig. 4), the image recording apparatus comprising: a panel section (column 5, line 9) which has input keys (column 5, line 11) operable to input a numerical value corresponding to at least one of the a number of copies (STP 1, STP 5, fig. 4) in the copy mode and a telephone number (STP 8, fig. 4) of a destination in the facsimile mode, and which has a start key (18a, fig. 4) which starts at least one of copying and facsimile transmission; and a controller (PPC 2,

column 6, lines 45-46) which determines whether or not the numerical value input by the panel section is the numerical value corresponding to the number of copies when the copy mode is set, and which, when the numerical value input by the panel section is not the numerical value corresponding to the number copies, does not start copying, (according to fig. 4, the copy operation cannot be started even if start key is depressed when the number entered is not a copy number) even if the start key is actuated, the controller further being configured to wait (inherent properties when entering number one in a time, STP 5, fig. 4) for another input by the panel section when the controller does not start copying.

Regarding claim 38: Matsunai teaches according to claim wherein the controller determines that the input numerical value corresponds to the number of copies by using, as a threshold value (STP 6, fig. 4) , a number of digits less than the number of digits utilized for the telephone number of the destination.

Regarding claim 39: Matsunai teaches wherein the another input by the panel section comprises an input of a reset key (clear, column 5, lines 15-20, return to initial state means reset).

Regarding claims 40, 46: Matsunai teaches an image recording apparatus (fig. 1) having a copy mode and a facsimile mode (fig. 4), the image recording apparatus comprising: a panel section (column 5, lines 9-10) which has input keys (column 5, line 11) operable to input a numerical value corresponding to at least one of the number of copies in the copy mode (before reaches 5, STP 6, fig. 4) and a telephone number of a destination in the facsimile mode (after reaches 5, STP 6, fig. 4); and a controller (PPC

2, column 6, lines 45-46) which determines, when the copy mode is set, whether or not a numerical value input by the panel section includes a predetermined character (e.g., the character of 11111 or 23478, STP 6, fig. 4), and which switches from the copy mode to the facsimile mode when the numerical value input by the panel section includes the predetermined character.

Regarding claim 41: Matsunai teaches wherein the predetermined character comprises a pause (inherently the character/phone number/copy number comprise a pause because users enter the number one at a time)

Regarding claim 42: Matsunai teaches wherein when the controller switches from the copy mode to the facsimile mode, the numerical value input by the panel section is retained, the retained numerical value being utilized in the facsimile mode (STP 7, fig. 4).

Regarding claim 43: Matsunai teaches wherein the controller combines digits of a numerical value input by the panel section in the facsimile mode with digits of the retained numerical value (STP 7, fig. 4), after the controller switches from the copy mode to the facsimile mode, and calls the destination based on the telephone number including the retained numerical value (STP 12, fig. 4, in order to fax, the telephone (fax) number must be called).

Regarding claim 45: Matsunai teaches a method for controlling an image recording apparatus (fig. 1) having a copy mode and a facsimile mode (fig. 4), the image recording apparatus having a start key (STP 3, STP 10, fig. 4) which starts at least one of copying and facsimile transmission, the method comprising: inputting a

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numerical value corresponding to at least one of a number of copies (smaller than 5, STP 6, fig. 4) in the copy mode and a telephone number (reaches 5, STP 6, fig. 4) of a destination in the facsimile mode; determining whether or not the input numerical value is a numerical value corresponding to the number of copies when the copy mode is set (STP 6, fig. 4); inhibiting of the copying when the input numerical value is not the numerical value corresponding to the number of copies (according to fig. 4, the copy operation cannot be started even if start key is depressed when the number entered is not a copy number), even if the start key is actuated; and waiting for another input (inherent properties when entering number one in a time, STP 5, fig. 4) when copying is inhibited.

Response to Arguments

9. Applicant's arguments filed 1/14/2005 have been fully considered but they are not persuasive.

With respect to applicant's argument "when the number of inputs by the keys 18b is 4 (less than the numeric limit (5) and more than the display capacity (3) of the display section 18e), the copy mode is not switched into the facsimile mode. In other words, the numeric limit (5) does not correspond to the display capacity (3) of the display section 18e in the copy mode, but rather corresponds to "numeric data, e.g., "5" which is difficult to be regarded as the number of copies or a magnification (col.6, lines 65-66). Thus, Matsunai does not disclose the controller which, when the copy mode is set and when the numerical value input by the panel section exceeds the display capacity of the

screen in the copy mode, switches from the copy mode to the facsimile mode. Rather, MATSUNAI switches when a number of digits input reaches a limit value (e.g., 5)," has been considered.

In reply: Column 5, lines 2-20 clearly teaches display of a copy number, magnification number which is limited to 5, as disclosed in fig. STP24, fig. 5.

With respect to applicant's argument "MATSUNAI does not disclose a controller which, when the copy mode is set and when the numerical value input by the panel section is not the numerical value corresponding to the number of copies, does not start copying, even if the start key is actuated. In addition, MATSUNAI does not disclose a controller which waits for another input by the panel section when the controller does not start copying, since MATSUNAI disclose only one input to STP 7 when the number that is not a copy number is entered (N=5) (STP6-STP7)," has been considered.

In reply: STP1 clearly shown that the system of Matsunai is set in copy mode, and STP6 is performed while the system is at the copy mode. Clearly, all computer require response time. Therefore, from the time the system has determined a yes of STP6, and before reaching STP7 (select fax mode), the system is not responding to any keyboard entry to the system-including the start key. Furthermore, the claims is only claiming determining whether or not the numerical value input by the panel section is the numerical value corresponding to the number of copies when the copy mode is set. The claim does not specify what mode the "does not start copying" is in. STP6, fig. 4, is the determining step which is in the copy mode of Matsunai. Fig. 4 of Matsunai is a

program particularly designed/configured for waiting to processed the next input of the panel section when the system has not start copying/printing.

With respect to applicant's argument " the combination of characters 11111 or 23478 is not a predetermined character, but rather is an arrangement of a predetermined number of any characters. The term " predetermined character" recited in claims 40, 42-43 and 46 refers to a specific character (or input) and does not refer to a predetermined number of any input characters. Step STP 6 of Fig.4 dose not refer to any particular (i.e., a predetermined) character, but to a predetermined number (5 or . less) of characters. Thus, MATSUNAI dose not comply with the requirements of claims 40, 42-43 and 46," has been considered.

In reply: Claim 40 is claiming the numerical value input by the panel section includes the predetermined character. If the applicant is claiming 0, 1, ...9, are the predetermined character, it is inherent in Matsunai's phone number. However, the specification does not disclose any of the number (0, 1, 2, ...9) would cause the system to switch from copy to fax mode.

The term "character" as defined by American Heritage Dictionary of the English Language, is one set of symbols, such as letters or NUMBERS, that are arranged to express information.

Therefore, the phone number as disclosed in the applicant's invention and Matsunai is the "character" as defined in the claims. This interpretation is based on the meaning given in the dictionary and the applicant's disclosure. The definition of the

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term "character" given by the applicant in the argument filed 1/14/2005 is not supported by the applicant's disclosure.

Conclusion

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to King Y. Poon whose telephone number is (571) 272-7440.

A handwritten signature in black ink, appearing to read 'King Y. Poon', is written above the printed name.

4/19/05

**KING Y. POON
PRIMARY EXAMINER**